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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,987	05/30/2001	Gregory D. Plowman	038602-1180	6720
22428	7590	02/17/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			SLOBODYANSKY, ELIZABETH	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/866,987

Applicant(s)

PLOWMAN ET AL.

Examiner

Elizabeth Slobodyansky, PhD

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): the 103(a) rejection of claim 6.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 6 and 33-37.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____



Elizabeth Slobodyansky, PhD
Primary Examiner
Art Unit: 1652

Continuation of 5. does NOT place the application in condition for allowance because: With regard to the 101 rejection, Applicants did not provide any evidence that either a polypeptide of SEQ ID NO:8 has PP2C activity or that it is highly homologous to a polypeptide for which said activity has been shown. The 112, 1st paragraph, written description and enablement rejections would remain at least because the term "phosphatase activity" encompasses various activities. The specification does not define said activities and does not disclose the correlation between the structure and function common to all members of the genus. With regard to the 112, 2nd paragraph rejection, Applicants argue that the specification describes the domains "in detail" (Remarks, page 11). This is not persuasive because the description is at most general and not specifically directed to a polypeptide of SEQ ID NO:8. In addition, said general description, is given by non-limiting examples. Further, amending claims 36 and 37 to recite "and a catalytic domain" renders the claims further confusing as it is unclear whether a contiguous or hybrid sequence is claimed. It is noted that the term "domain" is not identical to the term "fragment". With regard to the 103(a) rejection, Applicants argue that "it cannot be the case that a novel protein sequence is rendered obvious because a much shorter EST exists in the prior art" (page 12). The examiner agrees with that. Applicants arguments and the specification at pages 24-25 are taken as an evidence that the claimed polypeptide must be at least 90% identical to the entire sequence of SEQ ID NO:8. However, the 103 rejection of claim 33 would remain because the EST disclosed by Hillier et al. can be construed as encoding some domains such as, for example, C terminal domain. The purpose of creating the EST database is to provide the tool for identification the full length sequence. One of the routine approaches is to produce an antibody.